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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,268	04/03/2000	DANIEL RICHARD SCHNEIDEWEND	RCA89068	9731

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THOMSON LICENSING INC.
PATENT OPERATIONS
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EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/445,268	Applicant(s) SCHNEIDEWEND ET AL.	
	Examiner Michael Van Handel	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/27/2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 4/27/05. Claims **1-17** are pending. Claims **13** and **17** are amended:

Response to Arguments

2. Applicant's arguments with respect to claims **1-15** have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments filed 4/27/05 with respect to claims **16** and **17** have been fully considered but they are not persuasive.

With respect to claim **16**, the applicant argues that LaJoie et al. does not teach that canceling the purchase of a program also cancels the recording of the program. The examiner respectfully disagrees. LaJoie et al. discloses that if a user attempts to record an Impulse Pay-Per-View (IPPV) event, set-top terminal 6 will display an interactive warning window 270 alerting the user that the program has not been purchased. If the user presses the "C" application definable key 252 to cancel the purchase, the Barker is hidden and the user is returned to the previous menu (col. 21, l. 30-49)(Fig. 12). This functionality is also disclosed with respect to LaJoie et al.'s One-Touch Recording. If the user presses "C" with the purchase menu 496 displayed, the user is returned to the previous menu 492 (col. 29, l. 33-58)(Fig. 25). Thus, in canceling the program for purchase the program is automatically removed from a record list.

With respect to claim **17**, the applicant argues that LaJoie et al. does not teach a method in which an on screen display option is provided so that the user is afforded an opportunity to cancel the purchase of a program in response to cancellation of the

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recording of the program. The examiner respectfully disagrees. LaJoie et al. discloses that a single button may be operable to add an item to two different lists. Further, LaJoie et al. discloses removing a program from a list of programs to be purchased (col. 22, l. 25-31) or removing any timer (col. 22, l. 52-56)(Fig. 14) including recording timers. As stated in claim 16, LaJoie et al. also provides a conflict resolution method in which a user is presented with a warning menu when trying to record an IPPV event. Furthermore, LaJoie et al. provides that by canceling a program purchase in this scenario, the recording of the program is also cancelled. Given such, it would have been obvious to anyone of ordinary skill in the art at the time that the invention was made to modify LaJoie et al. to include a single button that could be used to remove the item from a purchase list in response to removal from a recording list, such as that taught by LaJoie et al.'s method of including a single button to remove an item from a recording list in response to removal from a purchase list, in order to prevent a user from accidentally purchasing a program they are no longer recording and never intended to watch at the time it is aired.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3, 6, 8, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Russo.

Referring to claim 1, Russo discloses an apparatus for receiving/processing a program/plurality of programs, comprising:

- user interface means for selecting a program from said plurality of programs (col. 9, l. 48-67)(col. 10, l. 1-8)(Fig. 2);
- an on screen user option indicating that a user can both purchase and record the selected program, so that the user does not have to select one of purchase and record user options and then select the other user option to purchase and record the selected program (Russo discloses that a provider can unlock an amount of viewing, either in terms of a number of hours or a level of credit or that a user may be billed at a periodic interval, and that a descrambling key can be generally available for use by the subscriber at the subscriber's site without having to download such a key on a per-selection basis. Thus, a user chooses a program to record with the intent of purchasing, and will not be required to select a purchase option in the future)(col. 6, l. 23-34, 42-61)(col. 10, l. 25-47)(Fig. 2);
- a controller, in response to a first user action for selecting a first program for recording, storing said first program in a first list representing a list of programs to be recorded (col. 4, l. 62-67)(col. 5, l. 1-4, 8-17), and in response to a second user action selecting said on screen user option for selecting a second program for both purchasing and recording (the examiner notes

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that in selecting the aforementioned user option, the user may or may not have the intent of purchasing it. Therefore, a user may record a program with the sole intent of recording, or with the intent of recording and purchasing the program), storing said second program on a second list (on-site library)(col. 11, l. 20-25), representing a list of programs purchased and also storing said second program on said first list (the program must have been stored on the record list prior to being stored in the on-site library)(col. 4, l. 57-60)(col. 5, l. 8-17, 55-57).

Referring to claims 3 and 8, Russo discloses the apparatus of claims 1 and 6, respectively, wherein said first list includes a purchase indication for said second program (the examiner notes that by selecting an item for recording, the user may be intend to purchase the program. The user indicates his/her purchasing intent by choosing to record the selection).

Referring to claim 6, Russo discloses an apparatus for processing a program, comprising:

- on screen display means for displaying a first list representing programs selected for recording (col. 9, l. 48-67)(col. 10, l. 1-8)(Fig. 2);
- on screen user control option indicating that a user can both purchase and record a program, so that the user does not have to select one of purchase and record user control options and then select the other user control option to purchase and record said

program (Russo discloses that a provider can unlock an amount of viewing, either in terms of a number of hours or a level of credit or that a user may be billed at a periodic interval, and that a descrambling key can be generally available for use by the subscriber at the subscriber's site without having to download such a key on a per-selection basis. Thus, a user chooses a program to record with the intent of purchasing, and will not be required to select a purchase option in the future)(col. 6, l. 23-34, 42-61)(col. 10, l. 25-47)(Fig. 2);

- on screen display means for displaying a second list representing programs selected for purchasing and recording (the examiner notes that in selecting the aforementioned user option, the user may or may not have the intent of purchasing it. Therefore, a user may record a program with the sole intent of recording, or with the intent of recording and purchasing the program); and
- control means, in response to selection of said user control option, entering said program into said second list and automatically entering said program into said first list (the examiner notes that by creating a list of programs for recording that the user intends to purchase, the program is automatically entered onto the recording list).

Referring to claim 13, Russo discloses a method for processing a plurality of programs, comprising:

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- selecting a first program for recording from said plurality of programs (col. 9, l. 48-67)(col. 10, l. 1-8)(Fig. 2);
- storing said first program in a first list (col. 4, l. 62-67)(col. 5, l. 1-4, 8-17);
- selecting a second program (col. 9, l. 48-67)(col. 10, l. 1-8)(Fig. 2);
- receiving a selection of a displayed user option indicating that a user can both purchase and record the selected second program, so that the user does not have to select one of purchase and record user options and then select the other user option to purchase and record the selected second program (Russo discloses that a provider can unlock an amount of viewing, either in terms of a number of hours or a level of credit or that a user may be billed at a periodic interval, and that a descrambling key can be generally available for use by the subscriber at the subscriber's site without having to download such a key on a per-selection basis. Thus, a user chooses a program to record with the intent of purchasing, and will not be required to select a purchase option in the future)(col. 6, l. 23-34, 42-61)(col. 10, l. 25-47)(Fig. 2);
- storing said second program in a second list (on-site library)(col. 11, l. 20-25); and

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- storing said second program in said first list (the program must have been stored on the record list prior to being stored in the on-site library)(col. 4, l. 57-60)(col. 5, l. 8-17, 55-57).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 4, 5, 7, 9, 10, 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo in view of Lajoie et al.

Referring to claims 2, and 7, Russo discloses a system as stated above in claims 1 and 6, respectively. Russo does not disclose the first list as including a timer conflict indication for programs having a timer conflict. LaJoie et al. discloses a system wherein the first list includes a timer conflict indication for programs having a timer conflict (col. 21, l. 30-42)(Fig. 12). It would have been obvious to anyone of ordinary skill in the art at the time that the invention was made to modify Russo to include a timer conflict indication such as that taught by LaJoie et al. in order to prevent a user from creating system function conflicts.

Referring to claims 4, 9, and 14, Russo discloses a system as stated above in claims 1, 6, and 13, respectively. Russo does not disclose that the controller first determines whether there is a timer conflict between said second program and another program on said first list before storing said second program on said first list. LaJoie et al. discloses a system wherein the controller first determines whether there is a timer

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conflict between the second program and another program on the first list before storing the second program on the first list (col. 21, l. 30-55). It would have been obvious to anyone of ordinary skill in the art at the time that the invention was made to modify Russo to include the controller with a method that first determines whether there is a timer conflict between the second program and another program on the first list before storing the second program on the first such as that taught by Lajoie et al. in order to prevent a user from creating system function conflicts.

Referring to claims 5, 10, and 15, Russo discloses a system as stated above in claims 1, 9, and 14, respectively. Russo does not disclose that the controller prompts a user to resolve said timer conflict if said timer conflict exists. LaJoie et al. discloses a system wherein the controller prompts a user to resolve the timer conflict by presenting the user with an interactive warning window (col. 21-22, l. 55-5)(Fig. 12). It would have been obvious to anyone of ordinary skill in the art at the time that the invention was made to modify Russo to include an interactive warning window in response to a timer conflict such as that taught by LaJoie et al. in order to resolve a timing conflict.

4. Claims 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo in view of Browne et al.

Referring to claim 11, Russo discloses an apparatus for processing a program, comprising:

- user interface means for selecting said program from said plurality of programs (col. 9, l. 48-67)(col. 10, l. 1-8)(Fig. 2);
- an on screen user option indicating that a user can both purchase and record said program, so that the user does not have to select

one of purchase and record user options and then select the other user option to purchase and record the selected program (Russo discloses that a provider can unlock an amount of viewing, either in terms of a number of hours or a level of credit or that a user may be billed at a periodic interval, and that a descrambling key can be generally available for use by the subscriber at the subscriber's site without having to download such a key on a per-selection basis. Thus, a user chooses a program to record with the intent of purchasing, and will not be required to select a purchase option in the future)(col. 6, l. 23-34, 42-61)(col. 10, l. 25-47)(Fig. 2);

Russo does not disclose a controller, in response to a user action for canceling said program, removing said program from a first list representing a list of programs purchased and automatically removing said program from a second list representing a list of programs to be recorded. Browne et al. discloses a cancel option 506 for canceling a program that was to be recorded (p. 24, l. 16-17)(Fig. 5E). It would have been obvious to anyone of ordinary skill in the art at the time that the invention was made to modify Russo to include a cancel button for aborting a record operation such as that taught by Browne et al. in order to allow the user to cancel an operation before it is performed. The examiner further notes that by removing a program from a list of programs to be recorded in the system of Russo, the program no longer can be purchased.

Referring to claim 12, Russo discloses an apparatus for processing a program, comprising:

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- on screen display means for displaying a first list representing programs selected for recording (col. 9, l. 48-67)(col. 10, l. 1-8)(Fig. 2);
- first user control means for selecting to both purchase and record a program (Russo discloses that a provider can unlock an amount of viewing, either in terms of a number of hours or a level of credit or that a user may be billed at a periodic interval, and that a descrambling key can be generally available for use by the subscriber at the subscriber's site without having to download such a key on a per-selection basis. Thus, a user chooses a program to record with the intent of purchasing, and will not be required to select a purchase option in the future)(col. 6, l. 23-34, 42-61)(col. 10, l. 25-47)(Fig. 2);
- on screen display means for displaying a second list representing programs selected for purchasing (the examiner notes that in selecting the aforementioned user option, the user may or may not have the intent of purchasing it. Therefore, a user may record a program with the sole intent of recording, or with the intent of recording and purchasing the program);

Russo does not disclose second user control means for removing a selected program from said first and second lists or control means, in response to said user removal of said program from said second list, automatically removing said program from said first list.

Browne et al. discloses a cancel option 506 for canceling a program that was to be

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recorded (p. 24, l. 16-17)(Fig. 5E). It would have been obvious to anyone of ordinary skill in the art at the time that the invention was made to modify Russo to include a cancel option for aborting a record operation such as that taught by Browne et al. in order to allow the user to cancel an operation before it is performed. The examiner further notes that by removing a program from a list of programs to be recorded in the system of Russo, the program no longer can be purchased.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571.272.5968. The examiner can normally be reached on Monday-Friday, 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571.272.7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Van Handel
Examiner

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MVH

A handwritten signature in black ink, appearing to read "C. Kelley", is positioned above the printed name.

CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600